

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
SHERMAN DIVISION

STMicroelectronics, Inc.,	§	
	§	
Plaintiff,	§	Civil Action No. 4:03-CV-276
	§	
v.	§	Judge Leonard E. Davis
	§	
MOTOROLA, INC.,	§	Jury Trial Demanded
	§	
Defendant,	§	
Counterclaim Plaintiff,	§	
	§	
v.	§	
	§	
STMicroelectronics, N.V., and	§	
STMicroelectronics, Inc.,	§	
	§	
Counterclaim	§	
Defendants	§	

**MOTOROLA, INC.'S MOTION FOR LEAVE TO JOIN
FREESCALE SEMICONDUCTOR, INC.**

Defendant and counterclaim plaintiff Motorola, Inc. ("Motorola") files this motion under Fed. R. Civ. P. 25(c) to join Freescale Semiconductor, Inc. ("Freescale") as a party in this cause, and in support thereof states:

**I.
BACKGROUND**

On or about July 18, 2003, STMicroelectronics, Inc. ("STINC") filed its Original Complaint ("Complaint") against Motorola alleging infringement by Motorola of three patents. On or about September 11, 2003, Motorola filed its Answer and Counterclaims, in which Motorola asserted counterclaims against STINC and STMicroelectronics, N.V. ("STNV") for declaratory judgment of non-infringement and for alleged infringement by STINC and STNV of certain Motorola Patents (as such term is defined in Motorola's First Amended Answer and

Counterclaims). STNV has asserted counterclaims against Motorola, which Motorola has answered.

II. FREESCALE SEMICONDUCTOR, INC.

Freescale is a wholly owned subsidiary of Motorola that recently acquired ownership of the Motorola Patents by virtue of the assignment of those patents by Motorola. The assignment of the Motorola Patents was made effective April 4, 2004 under the Intellectual Property Assignment Agreement ("Assignment Agreement") between Motorola and Freescale. In addition to the Motorola Patents, Motorola assigned thousands of other patents to Freescale under the Assignment Agreement. Together with the Assignment Agreement, Motorola and Freescale also entered into various other agreements to effectuate a transfer of the assets and liabilities of Motorola's semiconductor business to Freescale.

III. JOINDER OF FREESCALE IS APPROPRIATE

Where an interest in the subject matter of litigation is transferred during the pendency of the litigation, Fed. R. Civ. P. 25(c) permits the joinder of the successor entity. *See* Fed. R. Civ. P. 25(c) (permitting the transferee to be "joined with the original party"). Joinder is particularly appropriate where doing so will facilitate the ongoing course of the litigation. *See FDIC v. Tisch*, 89 F.R.D. 446, 448 (E.D.N.Y. 1981); *see also Dollar Dry Dock Sav. Bank V. Hudson St. Dev. Assocs.*, No. 92 Civ. 3737 (SAS), 1995 WL 412572, at *4 (S.D.N.Y. July 12, 1995).

Joining Freescale as a party to this case will facilitate the ongoing conduct of the litigation. Freescale now owns and operates the semiconductor business formerly owned and operated by Motorola. Persons formerly employed by Motorola in its semiconductor division are now employed by Freescale. Documents formerly in Motorola's possession are now in Freescale's possession. And certain of Motorola's rights and obligations are now rights and

obligations of Freescale. In these circumstances, joinder of Freescale is appropriate. *See General Battery Corp. v. Globe-Union, Inc.*, 100 F.R.D. 258, 263 (D. Del. 1982) (granting joinder of subsidiary under R. 25(c) where subsidiary was transferee of patents from original party to suit).

A proposed Second Amended Answer and Counterclaims that reflects the joinder of Freescale as a party is attached as Exhibit A. A proposed First Amended Reply of Defendants to Counterclaims of STMicroelectronics, N.V. is attached as Exhibit B.

IV. CONCLUSION

Motorola respectfully requests that the Court enter an order permitting the joinder of Freescale as a party to this action, and that the proposed amended pleadings that are attached as Exhibits A and B be accepted for filing among the papers in this cause.

Dated May 27, 2004.

Respectfully submitted,



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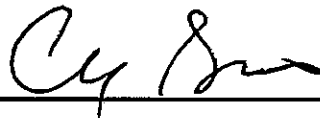
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CERTIFICATE OF CONFERENCE

The undersigned certifies that counsel for Motorola has conferred with opposing counsel regarding the joinder of Freescale Semiconductor, Inc. to this litigation. Opposing counsel requested copies of the proposed amended pleadings, which have very recently been provided to them. Opposing counsel has not yet advised Motorola of their position regarding the amendments. Motorola is hopeful that an agreement can be reached with opposing counsel such that an agreed order can be submitted at a later date. Motorola will advise the Court if an agreement is reached; otherwise, this motion is presented to the Court for determination.



CERTIFICATE OF SERVICE

The undersigned counsel for Plaintiff Motorola, Inc. hereby certifies that a true and correct copy of the foregoing was served upon the counsel identified below this __ day of May, 2004, as indicated:

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